

REMARKS

Applicant has carefully considered the final office action of August 25, 2005 and offers the following remarks and amendments.

Applicant initially amends four paragraphs of the specification to identify correctly element 18. Element 18 refers to a device agent, and element 20 refers to a user agent. Applicant inadvertently referred to device agents 18 as user agents 18 in these four paragraphs. Applicant herein corrects the errors. No new matter is added, but the specification is now in better form.

Claims 1-8, 10-21, 23-24, and 36-39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gudjonsson (hereinafter "Gud") in view of Kimchi et al (hereinafter "Kimchi"). Applicant respectfully traverses.

Applicant acknowledges that most inventions are combinations of known elements. One of the things that make an invention patentable is that there is no teaching or suggestion to combine the known elements in the manner claimed. The Federal Circuit recognizes that hindsight reconstruction is a subtle, but powerful influence on Examiners when evaluating obviousness. However, hindsight reconstruction remains impermissible. To combat the possibility of hindsight reconstruction in a combination of references, the Federal Circuit requires that the Patent Office do two things. First, the Patent Office must state a reason why the references should be combined, and second, the Patent Office must support the stated reason with actual evidence that documents the motivation to combine the references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). In *Dembiczak*, the Federal Circuit acknowledged that there are a number of places where the motivation may be found, but stressed that the range of available sources does not diminish the requirement for actual evidence. *Id.*

Applicant previously argued that the Patent Office had not properly supported the motivation to combine Gud and Kimchi because the Patent Office had not provided any evidence to support the motivation to combine the references. In the main body of the current Office Action, the Patent Office repeats its error. That is, the Patent Office states that the motivation to combine the references "is that Kimchi system's ability to combine (via software) physical devices gives the combination a communication ability that is not afforded by individual devices alone. For example, a video input device and phone allows one to use a virtual videophone."

(Office Action of August 25, 2005, page 6, lines 15-18). This stated motivation still lacks any supportive evidence and is improper.

The Patent Office, in its "Response to Remarks" section beginning on page 2 of the Office Action of August 25, 2005 misunderstands Applicant's arguments. Specifically, the Patent Office hypothesizes that Applicant meant either "(1) there is no evidentiary support that Kimchi system's does not have an ability to combine physical devices into a virtual device to give the virtual device added capabilities or (2) whether such capability do not provide the proper motivation to improve on Gud." (Office Action of August 25, 2005, page 2, lines 17-20). The second hypothesis is closer to Applicant's argument, but still not what Applicant argued. As explained above, to prevent hindsight reconstruction, the Patent Office must set forth a motivation to combine the references. The Patent Office's statement "that Kimchi system's ability to combine (via software) physical devices gives the combination a communication ability that is not afforded by individual devices alone" is the motivation of record. After setting forth a motivation to combine the references, the Patent Office must support the stated motivation with actual evidence as required by the Federal Circuit. *Dembiczak*. That is, there must be evidence and not merely an unsupported assertion that there is a reason to combine the references. The Patent Office's motivation "that Kimchi system's ability to combine (via software) physical devices gives the combination a communication ability that is not afforded by individual devices alone" lacks supportive evidence and therefore remains an unsubstantiated assertion. As such, the motivation is improper.

The Patent Office's analysis of its first hypothesis is that Kimchi is capable of combining physical devices. This analysis is irrelevant with regard to a motivation to combine the references. There must be evidence to support combining Gud and Kimchi for the reasons set forth by the Patent Office. As the analysis provided by the Patent Office in its discussion of its first hypothesis does not provide evidence that suggests combining the references than the Patent Office's motivation remains improper.

The Patent Office's second hypothesis is that Kimchi provides the ability for a virtual laptop. It includes a citation to Kimchi, paragraph 0075, but it remains unclear how this citation provides any evidence. The Patent Office's statement "that Kimchi system's ability to combine (via software) physical devices gives the combination a communication ability that is not afforded by individual devices alone" does not amount to a suggestion to combine the references.

In short, the Patent Office has not provided an explanation for why someone of ordinary skill in the art would, upon reading Gud and Kimchi, be suggested to combine Gud with Kimchi.

Merely because a combination is possible does not make the combination obvious. MPEP § 2143.01. The Patent Office merely asserts that the combination would give Gud additional functionality. Presumably all combinations of references give the original references additional functionality, but that does not mean that there is a motivation or suggestion to combine the references. By way of example, a chainsaw and a telephone could be combined so as to give the combination a communication ability not afforded by the individual devices alone, but there is no reason why someone of ordinary skill in the art would care to combine a chainsaw with a telephone.

Since the Patent Office has not provided Dembiczak's evidence about the suggestion to combine the references, the combination of references is improper. Since the combination of references is improper, the rejection based on the combination is improper. Since the rejection is improper, the Patent Office has not established obviousness, and the claims are allowable. Applicant requests withdrawal of the § 103 rejection of the claims at this time.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. There remains no evidence to suggest combining the references in the manner claimed. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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